



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,891	03/04/2002	John MacEachern	12403-4	1840
1059	7590	05/27/2004		
BERESKIN AND PARR SCOTIA PLAZA 40 KING STREET WEST-SUITE 4000 BOX 401 TORONTO, ON M5H 3Y2 CANADA			EXAMINER MENDIRATTA, VISHU K	
			ART UNIT 3712	PAPER NUMBER

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,891

Applicant(s)

MACEACHERN, JOHN

Examiner

Vishu K Mendiratta

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-20 and 27-40 is/are pending in the application.
- 4a) Of the above claim(s) 27-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-20 and 38-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 20 recites the limitation "the group" in claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

3. Claims 1, 5-10 and 16-19, 20,38,39 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Grady in view of Ex.Parte Breslow 192 USPQ 431.

O'Grady teaches a game comprising a game board having general scoring area (col.3, lines 7-9) with a square shape and numerals as surface images, one or more blocking pieces (lower disc and upper disc, see col3, lines 57-59), pieces are tossed on the game board (col.1, lines 56-57), pieces and board having magnets for mutual attraction (abstract), teaching further structural layers for construction of magnetic board as means for attachment and magnetic pieces (col.2, lines 42-68), projectiles of any shape col.3, line 34).

O'Grady further teaches blocking pieces distinct from scoring pieces (3:10-25).

Note that "area remaining uncovered" is a method of playing and no further limitation is added to the apparatus by this limitation.

O'Grady teaches distinguishing indicia on game pieces for example Fig.4 having distinguishing indicia on each piece.

Applicant might argue that the distinction between applicant's "feature" and the cited reference "feature" lies in the printing of a "goalkeeper" or "hockey player".

Difference between the applicant's "blocking/ scoring pieces" and the pieces in the cited reference reside in meaning and information conveyed by printed matter are not considered patentable differences.

In order to create a variation for attracting players it would have been obvious to modify O'Grady indicia with other indicia.

One of ordinary skill in art at the time the invention was made would have suggested modifying O'Grady pieces in Fig. 4 by printing hockey player pictures for making the game attractive to players.

4. Claims 11-15 rejected under 35 U.S.C. 103(a) as being unpatentable over O'Grady in view of Ex. Parte Breslow as applied to claim 1 above, and further in view of Stuart.

O'Grady in view of Ex. Parte Breslow teaches all limitations of these claims except that it does not explicitly teach hook and loop attachment means.

Stuart in a similar game teaches hook and loop arrangement (Fig.1).

Hook and Loop arrangement is an art recognized attachment means commonly known for long time. In order to attach pieces it would have been obvious to use any attachment means including hook and loop such as demonstrated by Stuart.

One of ordinary skill in art at the time the invention was made would have used hook and loop attachment means.

Response to Arguments

5. Applicant's arguments filed 09/22/03 have been fully considered but moot in view of new grounds of rejection.

Examiner takes the position that the only difference between applicant's game and prior art resides between the printed indicia not considered patentable.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number is (703) 306-5695. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

Art Unit: 3712

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Vishu K. Mendiratta
Primary Examiner
Art Unit 3712

VKM
May 20, 2004